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WOODLING, KROST AND RUST 9213 CHILLICOTHE ROAD KIRTLAND, OH 44094			EXAMINER FLORES SANCHEZ, OMAR	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRY H. JENKINS

Appeal 2009-009846
Application 09/580,412
Technology Center 1700

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Applicant appeals to the Board from the decision of the Primary Examiner rejecting for at least the second time claims 11-25 in the Office Action mailed March 8, 2007. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2007).

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

We affirm the decision of the Primary Examiner.

Claims 11, 14, and 20 illustrate Appellant's invention of a steel rule die, and are representative of the claims on appeal:

11. A steel rule die including in combination
a metal plate,
a top board located on top of said metal plate,
a plurality of rule slots in said top board,
a steel rule in said slots

each of said steel rules being generally flat to fit in a slot and having a bottom portion adjacent said metal plate and a top portion formed into a cutting edge residing above the surface of said top board,

each said steel rule extending on a longitudinal axis and having first and second end portions,

said first end portion extending at approximately a 45 degree angle to said longitudinal axis and on one side of said axis,

said first end portion of a given steel rule engaging a next adjacent steel rule to form a 45 degree angled corner.

14. A rule for use in a steel rule die including a metal member having upper and lower edge portions and first and second end portions,

said first end portion extending at an angle to the extent of said metal member and in a first direction,

said second end portion extending at an angle to the extent of said metal member and in a second direction,

said upper edge portion having a cutting edge formed thereon.

20. A rule for use in a steel rule die including a metal member having upper and lower edge portions and first and second end portions,

said first end portion extending at [sic] angle to the extent of said metal member and in a first direction, and

said upper edge portion having a cutting edge formed thereon.

Appellant requests review of the following grounds of rejection advanced on appeal by the Examiner² (Br.³ 13-14):

claims 14, 15, 17, 20, 21, and 23 under 35 U.S.C. § 102(b) over Shinnick (US 1,635,964) (Ans. 3);

claims 20-23 under § 102(b) over Svendsen (US 3,464,293) (Ans. 3);

claims 11-13 under 35 U.S.C. § 103(a) over Shinnick in view of Sandford (US 6,085,625) and Svendsen (Ans. 4);

claims 16 and 22 under § 103(a) over Shinnick in view of Svendsen (Ans. 5);

claims 18, 19, 24, and 25 under § 103(a) over Shinnick in view of Simms (US 3,335,628) (Ans. 5);

claim 24 under § 103(a) over Svendsen in view of Simms (Ans. 6); and

claim 25 under § 103(a) over Svendsen in view of Simms as applied to claims 20, 23, and 24, and further in view of Brayton (US 5,943,935) (Ans. 6).

Appellant argues the grounds of rejection on representative claims 11, 14, 16, 18, 20, 24, and 25, and on other claims to the extent argued in the Brief. *See generally* Br. Thus, we decide this appeal based on these claims. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Opinion

I. Claim 14: § 102(b) – Shinnick

A. Independent Claim 14

Appellant contends that the Examiner erred in finding that the steel rule in the paper box die embodiment illustrated in Shinnick Figure VIII

² The Examiner has withdrawn the ground of rejection of claims 19 and 25 under 35 U.S.C. § 112, second paragraph. Ans. 2.

³ We considered the Brief filed April 26, 2008, and the Examiner's Answer mailed December 30, 2008.

anticipates claim 14 because, Appellant argues, Figure VIII “does not disclose the first and second portions of the claim [sic, claimed rule] which extend in opposite directions.” Br. 16. Appellant contends that “the problem with Shinnick” is that “[a] plurality of identical Shinnick rules cannot be simply arranged with each other to produce an inexpensive steel rule die,” and Shinnick’s Figure VIII “shows the type of curved configuration which requires a skilled die maker to construct.” Br. 17. We disagree.

The Examiner finds that Shinnick Figure VIII shows a steel rule member C which has “first and second end portions extending in a first and a second direction[s].” Ans. 3. In a copy of Shinnick Figure VIII, the Examiner identifies the “first end portion” of rule C as extending out from the left side of Figure VIII, and the “second end portion” of rule C as extending along the top of Figure VIII. Ans. 7-8.

We agree with the Examiner’s findings with respect to Shinnick Figure VIII. We find that the two rules C form a corner or angle at the upper right corner of Figure VIII. *See* Shinnick p. 3, ll. 5-6. Thus, the first end portion of the rule C in the lower left corner of Figure VIII extends in a first direction at an angle to the extent of the same rule C along the left side of Figure VIII, and the second end portion of the same rule C along the upper end of Figure VIII extends in a second direction at an angle to the extent of the same rule C along the left side of Figure VIII. This is all that the plain language “said first end portion extending at an angle to the extent of said metal member and in a first direction,” and “said second end portion

extending at an angle to the extent of said metal member and in a second direction” of claim 14 requires.

Accordingly, on this record, the Examiner has established, as a matter of fact, that Shinnick Figure VIII describes to one skilled in this art each and every limitation of the claimed rule encompassed by claim 14 arranged as required therein within the meaning of § 102(b). *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983) (anticipation is established when the claim reads on something disclosed in the reference which meets all of the limitations of the claim).

We are not convinced by Appellant’s position with respect to Shinnick’s “problem” with rule construction and use in a die. We agree with the Examiner that Appellant’s “problem” view of Shinnick does not address a limitation in claim 14 and thus does not patentably distinguish over the reference. *See, e.g., In re Self*, 671 F.2d 1344, 1350-51 (CCPA 1982). Indeed, claim 14 plainly reads on the rule C described in Shinnick’s Figure VIII which is used in a “die,” and claim 14 does not limit the manner of “steel rule die” in which the steel rule is used. Thus, claim 14 is anticipated. *See, e.g., Kalman*.

B. Independent Claim 20

As Appellant points out, claim 20 specifies only a “first end portion extending at [sic] angle to the extent of said metal member [of a rule] in a first direction,” thus differing from claim 14. Br. 18. Accordingly, claim 20 reads on the rule C in Shinnick Figure VIII and is anticipated in the same manner as claim 14. *See, e.g., Kalman*.

C.

Accordingly, as Appellant argues, claims 15 and 17 fall with claim 14 and claims 21 and 23 fall with claim 20, and on this basis, we affirm the ground of rejection of these claims over Shinnick under 35 U.S.C. § 102(b). *See* Br. 18.

I. Claim 20: § 102(b) – Svendsen

A. Independent Claim 20

Appellant contends that the Examiner erred in finding that the steel rule in the die embodiment illustrated in Svendsen’s Figures anticipates claim 20, arguing that Svendsen “discloses the problems [of construction] the present invention solves” and thus the “rejection suffers from the same deficiencies as discussed above [with respect to Shinnick] and it does not disclose the [claimed] invention.” Br. 18.

Appellant’s position does not specifically identify error in the Examiner’s position that claim 20 reads on the rules illustrated in Svendsen’s Figures. Ans. 4. Appellant’s “problem” view of Svendsen does not address a limitation in claim 20. *See, e.g., Self*. On this record, the Examiner has established Svendsen anticipates claim 20.

B. Dependent Claim 22

Appellant contends that the Examiner erred in finding that the steel rule in the die embodiment illustrated in Svendsen Figure 20 anticipates claim 22, arguing that in addition to the “problem” discussed with Svendsen, claim 22 modifies claim 20 in that claim 22 “contains the 45 degree limitation which cannot be found in the art.” Br. 19.

Appellant’s position does not specifically identify error in the

Examiner's position because Appellant does not explain why claim 22 does not read on the rules described by Svendsen. Ans. 4. Thus, on this record, the Examiner has established that Svendsen anticipates claim 22.

C.

Accordingly, as Appellant argues, claims 21 and 23 fall with claim 20, and thus, we affirm the ground of rejection of claims 20-23 over Shinnick under 35 U.S.C. § 102(b). *See* Br. 19.

III. Claim 11: § 103(a) – Shinnick, Sandford, and Svendsen

A. Independent Claim 11

Appellant contends that the Examiner erred in holding that the combined teachings of Shinnick, Sandford, and Svendsen renders obvious the claimed steel rule die encompassed by claim 11. Appellant relies on positions previously expressed with respect to each of Shinnick and Svendsen. Br. 19. Appellant contends that “Sandford’s plate 52 is not the plate of [claim 11],” arguing that Sandford Figures 5A-B show that “plate 52 has a slot which extends clear through which does not provide support against force on the cutting edge of rule 20.” Br. 19. Appellant further contends that the combination of references “does not come up with the claimed invention” because the result is construction “problems” and “the die is not constructed of identical rules with 45 degree ends which engage each other to provide a strongly supported juncture.” Br. 19-20. We disagree with Appellant’s position.

With respect to Appellant’s contention that Sandford’s plate 52 does not meet the “plate” limitations of claim 11, we determine that the plain language of claim 11 specifies that the steel rule die has any manner of “a

metal plate” which permits “each of said steel rules” to have “a bottom portion adjacent said metal plate” in any manner. Indeed, the plain language of claim 11 specifies only that the steel rule is “adjacent said metal plate,” that is, the steel rule is “next to” the metal plate in any respect. We recognize that the Specification, in describing the embodiment illustrated in Specification Figure 14, discloses that “lower edge portion 74 of the rules is adapted to engage the metal backup plate 36 . . . so that when the cutting operation is performed the force required to perform the cutting operation will not cause the rules to move out of position.” Spec. 11:3-6. In this respect, we find that Specification Figure 14 discloses that each steel rules 70 rest on top of and thus, in this manner, “engages” plate 36. *See* Spec. 10:19 to 11:3. However, even in light of this disclosure, there is no basis in the plain language of claim 11 or in the Specification on which to read into claim 11 any limitation encompassing a disclosed embodiment wherein the metal plate has a particular structure and/or performs a specific function with respect to a steel rule “adjacent” thereto. *See* Ans. 9. *See, e.g., In re Suitco Surface, Inc.*, 603 F.3d 1255, 1259 (Fed. Cir. 2010) (“During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification.”) (citing *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citing *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005)(en banc); *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997); *In re Van Geuns*, 988 F.2d 1181, 1184-185 (Fed. Cir. 1993); *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989).

Thus, we cannot agree with Appellant that Sandford's plate 52 does not meet the "plate" limitations of claim 11. Indeed, Appellant has not established that Sandford's steel rules 20 are not "adjacent" steel plate 52 and thus would not "[increase] the stability of the rule die" as the Examiner finds. Ans. 4 and 9. *See* Sandford, e.g., col. 6, l. 19 to col. 7, l. 23, and Fig. 1. This is all that claim 11 requires.

Turning now to Appellant's contention that the combination of references does not suggest that "the die is . . . constructed of identical rules with 45 degree ends," we note that the Examiner relies on the combination of Shinnick and Svendsen with respect to the limitation that "said first end portion of a given steel rule engaging a next adjacent steel rule to form a 45 degree angled corner" in claim 11. Ans. 4-5. Appellant's contention does not specifically identify error in the Examiner's application of the combined teachings of Shinnick and Svendsen to claim 11 in this respect. Br. 19-20.

B.

Accordingly, as Appellant argues, claims 12 and 13 fall with claim 11, and thus, we affirm the ground of rejection of claims 11-13 over the combination of Shinnick, Sandford, and Svendsen under 35 U.S.C. § 103(a). *See* Br. 20.

IV. Claim 16: § 103(a) – Shinnick and Svendsen

A. Dependent Claim 16

Appellant contends that the Examiner erred in holding that the combined teachings of Shinnick and Svendsen renders obvious the claimed rule encompassed by claim 16. Appellant relies on positions previously expressed with respect to each of Shinnick and Svendsen. Br. 20. Appellant

contends that Shinnick does not disclose “the end portion of the rule as properly construed . . . and . . . the Examiner acknowledges [that Shinnick] does [not] show the end portions formed at an approximately 45 degree angle.” Br. 20. Appellant contends Svendsen “does not teach . . . a 45 degree angle but rather a myriad of angles none of which are taught to be important.” Br. 20. Appellant contends that “[t]he Examiner comments that the 45 degree angle is to create the desired shape of cut but seems to ignore that in Applicant’s device the 45 degree angle is to provide support and to enable the end to end assembly that enables identical off-the-shelf rules to be used to easily construct a die.” Br. 20-21. We disagree.

The Examiner finds that Shinnick discloses a rule that differs from the rule of claim 16 in that the end portions are not formed at approximately 45 degree angles, and that Svendsen discloses that the end portions of a rule can “range between 10 to 90 degrees angle for the purpose of creating the desired shape of cut.” Ans. 5 and 10, citing Svendsen col. 3, ll. 59-67. The Examiner concludes that the combined teachings of Shinnick and Svendsen would have led one of ordinary skill in the art to modify Shinnick’s rule by “providing the approximately 45 degree angle in order to create the desired shape of cut.” Ans. 5. The Examiner contends that Appellant’s contentions are directed to an “intended use recitation is not disclosed in” claim 16. Ans. 10.

We agree with the Examiner’s finding of fact from the teachings of Shinnick and Svendsen. *See above* p. 4. We emphasize that one of ordinary skill in this art would have recognized that the rule C illustrated on the left side of Shinnick Figure VIII has angled end portions which gradually curve

to an approximately 90 degree angle. *See above* p. 4. Thus, as the Examiner concludes, one of ordinary skill in this art would have modified Shinnick's rule to have curved end portions wherein the curved ends can be angled as desired in the range of 10 to 90 degrees as taught by Svendsen, including an angle of approximately 45 degrees as claimed in claim 16.

On this record, we agree with the Examiner that Appellant's contention that the claimed rule is essential to "Applicant's device" is an argument directed to an intended use not reflected in a limitation in claim 16. Indeed, claim 16 further limits the steel rule of claim 15 which in turn further limits the "rule" specified in claim 14. In this respect, we determined that claim 14 does not limit the manner of "steel rule die" in which the steel rule is used. *See above* p. 6.

B.

Accordingly, as Appellant argues, claim 22 falls with claim 16, and thus, we affirm the ground of rejection of claims 16 and 22 over the combination of Shinnick and Svendsen under 35 U.S.C. § 103(a). *See Br. 20.*

V. Claim 18: § 103(a) – Shinnick and Simms

A. Dependent Claim 18

Appellant contends that the Examiner erred in holding that the combined teachings of Shinnick and Simms renders obvious the claimed rule encompassed by claim 18. Appellant relies on positions previously expressed with respect to Shinnick. *Br. 21.* Appellant contends claim 18 "refers to the terminating end of each of the first and second end portions formed on an angle to the vertical." *Br. 21.* Appellant further contends that

“Simms fails to show or suggest where and how his structure might be incorporated into Shinnick to meet the claim language.” Br. 21. We cannot subscribe to Appellant’s position.

The Examiner finds that “Shinnick doesn’t show a terminating end of each of the first and second end portions formed on an angle to the vertical axis.” Ans. 5. The Examiner further finds that Simms teaches “the use of a terminating end of each of the first and second end portions (21 and 35) formed on an angle to the vertical axis for the purpose of facilitating the formation of strong and accurate joint.” Ans. 5 and 10, citing Simms Figs. 2 and 6. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to modify “Shinnick’s steel rule by providing the terminating end of each of the first and second end portions formed on an angle to the vertical axis as taught by [Simms] in order to facilitate the formation of strong and accurate joint and eliminate the gap between the cutting edges of the joint to avoid incomplete cut of the work piece.” Ans. 5-6.

We agree with the Examiner’s findings of fact from the teachings of Simms. *See* Simms, e.g., col. 1, ll. 14-18, 25-30, and 45-60; col. 3, l. 39 to col. 4, l. 10; and Figs. 6 and 7. Indeed, we find that Simms would have disclosed to one of ordinary skill in the art in Figure 6 that insert 70 has first and second end portions 74, 84 which are formed at an angle to the vertical axis with respect to cutting edge 72, wherein cutting edge 72 “extends axially a greater distance than other portions of the terminating end” as specified in appealed claim 18. Simms, e.g., col. 3, l. 39 to col. 4, l. 10. We found that Shinnick would have disclosed to one of ordinary skill in the art

that two rules C form a corner or angle at the upper right corner of Shinnick Figure VIII. *See above* p. 4.

Thus, on this record, we determine that, contrary to Appellant's position, one of ordinary skill in this art would have been led by Simms to modify the end portions of Shinnick's rules C by following the design of inset 70 illustrated in Simms Figure 6, as pointed out by the Examiner.

B. Dependent Claim 24

Appellant contends that the Examiner erred in holding that the combined teachings of Shinnick and Simms renders obvious the claimed rule encompassed by claim 24. Br. 22. Appellant contends that "there is nothing in Simms which would suggest a structure which would enable steel rules to be assembled in end to end relationship to form a corner where the cutting edge extends a greater distance than the other portions." Br. 22. We disagree.

We determine that claims 18 and 24, ultimately dependent on independent claims 14 and 20, respectively, and read essentially the same, the difference being that claim 18 specifies the structure of both end portions of a steel rule while claim 24 specifies the structure of only one end portion of a steel rule. We further determine that claim 24 does not include a limitation with respect to assembling steel rules to form a corner as argued. *See, e.g., Self*. Thus, the combined teachings of Shinnick and Simms apply to claim 24 in the same manner as to claim 18, as the Examiner contends.

C.

Accordingly, as Appellant argues, claims 19 and 25 fall with claims 18 and 24, respectively, and thus, we affirm the ground of rejection of

claims 18, 19, 24, and 25 over the combination of Shinnick and Svendsen under 35 U.S.C. § 103(a). *See* Br. 21-22.

V. Claim 24: § 103(a) – Svendsen and Simms

Appellant contends that the Examiner erred in holding that the combined teachings of Svendsen and Simms renders obvious the claimed rule encompassed by claim 24. Appellant contends that Svendsen does not “substantially disclose the invention except for the terminating end portions” of the claimed rule specified in claim 24; that there is no suggestion of how Svendsen and Simms are to be combined; and that the “references do not teach how two of the claimed rules can be combined to produce a corner.” Br. 22. We disagree.

We have interpreted claim 24 as limited to specifying the structure of an end portion of a steel rule and does not include a limitation with respect to assembling steel rules to form a corner. *See above* pp. 12-13. We agree with the Examiner’s findings that Svendsen would not have disclosed to one of ordinary skill in the art a rule having an end portion that terminates at an angle to the vertical axis, and that Simms would have disclosed to this person that the end portion can have such structure. *See above* pp. 10 and 12. We find that Svendsen’s Figures 14-17 would have illustrated to one of ordinary skill in this art combining rules to form a joint. Svendsen, e.g., col. 4, ll. 44-59. Thus, on this record, agree with the Examiner’s conclusion that it would have been obvious to one of ordinary skill in the art to modify Svendsen’s “steel rule . . . by providing the terminating end of each of the first and second end portions formed on angle to the vertical axis as taught by [Simms] in order to facilitate the formation of strong and accurate joint

and eliminate the gap between the cutting edges of the joint to avoid incomplete cut of the work piece.” Ans. 6.

With respect to Appellant’s contention that the combination of Svendsen and Simms do not teach how two rules can be combined to produce a corner, we further determined that claim 24 does not include a limitation with respect to assembling steel rules to form a corner as argued. *See, e.g., Self*. In any event, Svendsen illustrates how to combine rules to form a corner.

Accordingly, we affirm the ground of rejection of claim 24 over the combination of Svendsen and Simms under 35 U.S.C. § 103(a).

VI. Claim 24: § 103(a) – Svendsen, Simms, and Brayton

Appellant contends that the Examiner erred in holding that the combined teachings of Svendsen, Simms, and Brayton renders obvious the claimed rule encompassed by claim 25. Br. 23. Appellant relies on positions previously expressed. Br. 25. Appellant notes “that Claim 25 is said to stand or fall with Claim 24,” and so stated with respect to the ground of rejection over Shinnick and Simms. Br. 21-22 and 23. “Appellant does not take the position that slots in the bottom of a steel rule per se is novel and patentable. It is patentable in the recited combination.” Br. 23.

We cannot agree with Appellant’s position. The Examiner relies on the combination of Svendsen and Simms as applied to, among others, claim 24. Ans. 6. Appellant does not contend that Brayton is in issue.

Accordingly, on this record, in view of our affirmance of the ground

of rejection of claim 24 over Svendsen and Simms, we further affirm the ground of rejection of claim 25, dependent on claim 24, over the combination of Svendsen, Simms, and Brayton under 35 U.S.C. § 103(a).

The Primary Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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